

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-8 and 11-13 are rejected under 35 USC 102(b) over the U.S. patent to Iwabuchi.

Claims 1-11 are also rejected under 35 USC 102(e) over the U.S. patent to Kamdem et al.

Claims 9 and 10 are rejected 35 USC 103(a) over the patent to Kamdem et al.

Claim 14 is rejected under 35 USC 103(a) over the U.S. patent to Iwabuchi in view of the U.S. patent application publication to Tabuchi et al.

The disclosure is objected to and the claims are rejected under 35 USC 112.

After carefully considering the Examiner's grounds for formal objections and rejections, applicants amended the specification and the claims. It is believed that the grounds for the formal objections and

rejections should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 1, the broadest claim on file, by incorporating into it the features of Claims 8 and 11.

Claim 1 as currently amended, in addition to other features, defines that the vibration-damping element has an outer toothing which is engaged with an inner toothing of the pulley, and tooth height of teeth of the inner toothing of the pulley is greater in every operating state than the tooth height of teeth of the outer toothing of the vibration-damping element.

As disclosed on page 3, lines 4-7, the advantage of a greater height of teeth of inner toothing of the pulley compared to the height of teeth the outer toothing of the vibration-damping element allows unrestricted thermal expansion of the teeth despite different thermal expansion coefficients.

Turning now to the references and in particular to the patents to Iwabuchi, Kamdem et al and Tabuchi et al, it is respectfully

submitted that these references do not disclose the above-mentioned new features of the present invention as now defined in amended Claim 1, and the devices disclosed in the references do not provide for advantages which are provided by the device for transmitting torque in accordance with the present invention as now defined in amended Claim 1.

As for the Examiner's rejection of the claims as being anticipated by the references, it is believed to be advisable to cite the decision In *Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, none of the references discloses each and every element of the present invention as now defined in amended Claim 1.

Therefore, the anticipation rejection of the original claims should be considered as not tenable with respect to amended Claim 1 and should be withdrawn.

The references also do not contain any hint, or suggestion, or motivation for the new features of the present invention which are now

defined in Claim 1. In order to arrive at the present invention from the teachings of the references, the references have to be fundamentally modified in particular by including into them the new features of the present invention which are now defined in amended Claim 1 and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, the present invention provides for the highly advantageous results which were emphasized hereinabove and which cannot be accomplished by the devices disclosed in the references. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments it is believed that Claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

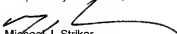
As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", with a long horizontal flourish extending to the right.

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